



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,045	04/24/2001	Joachim Endler	Q64014	3698

7590 01/14/2005
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3213

EXAMINER

GAUTHIER, GERALD

ART UNIT PAPER NUMBER

2645

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/840,045

Applicant(s)

ENDLER, JOACHIM

Examiner

Gerald Gauthier

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claim(s) 1-8 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hou et al. (US 5,325,421) in view of Barber et al. (US 5,251,251).

Regarding **claim(s) 1**, Hou discloses a telecommunication system (column 1, lines 10-11), comprising:

a first (column 12; line 33 "the calling party") and second terminal (S1 on FIG. 1);

a switch (CO 225 on FIG. 1) having a detector (Controller 45 on FIG. 1) and a processor (Host Processor 5 on FIG. 1);

a memory (Voice Message System 300 on FIG. 1) for storing at least one message originating from the first terminal and destined for the second terminal, the at least one message being associated with a specific signal generated by the first terminal (column 12, lines 24-40) [The caller calls a subscriber and leaves a voice message for the subscriber at the voice message system 300];

Hou disclose the calling party leaving a message from the called subscriber but fails to disclose the message being associated with a specific signal generated by the

Art Unit: 2645

first terminal and the second terminal sending the specific signal to receive the message.

However, Barber teaches the message being associated with a specific signal generated by the first terminal (column 4, lines 22-27) [The caller leaves a message with a unique access code for the message recipient to use to retrieve the personalized message].

the second terminal comprising:

a generator for generating the specific signal to be sent to the switch, the specific signal indicating that a user of the second terminal is interested in the at least one message associated with the specific signal, wherein in response to detecting the specific signal, the processor of the switch automatically orders the memory to generate and send the at least one message to the second terminal (column 5, lines 1-19) [The recipient calls the system and enters the access code and after verification the system plays the message associated with that particular code].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modified Hou using the facility as taught by Barber.

This modification of the invention enables the system of Hou to have a memory for the specific access code so that the recipient would receive a special greeting associated with a code.

Regarding **claim(s) 2 and 6**, Barber teaches the specific signal comprises a destination signal defining a destination of the first terminal or comprises a predefined specific code (column 4, lines 11-27).

Regarding **claim(s) 3 and 7**, Barber teaches a further generator for generating an indication signal to be sent to the switch and identifying at least one message originating from a user of the first terminal being a specific message, the switch further comprising a detector for detecting the indication signal (column 4, lines 11-27).

Regarding **claim(s) 4 and 8**, Barber teaches the indication signal comprises at least a predefined indication code or a destination signal defining a destination of the second terminal (column 4, lines 11-27).

Regarding **claim(s) 5**, Hou and Barber teaches all the limitations of **claim(s) 5** as stated in **claim(s) 1**'s rejection above and further more disclose a memory (300 on FIG. 1) and a detector (25 on FIG. 1).

Regarding **claim(s) 10**, Hou and Barber disclose all the limitations of **claim(s) 10** as stated in **claim(s) 1**'s rejection above and furthermore Barber teaches detecting, by a switch, the specific signal (column 3, lines 54-63) [The central computer 100 detects the access code from the recipient]; and

Art Unit: 2645

ordering, automatically in response to detecting the specific signal, the memory to generate the at least one specific message to be sent to the second terminal (column 5, lines 8-19) [The central computer 100 after verification of the unique access code enters by the caller instructs the facility to play the message associated with that access code].

Response to Arguments

3. Applicant's arguments with respect to **claim(s) 1-8 and 10** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GERALD GAUTHIER
PATENT EXAMINER

g.g.
December 30, 2004


FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600